



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/614,118 07/11/00 CANNELL

D 5725.0393

EXAMINER

HM12/0907

FINNEGAN HENDERSON FARABOW GARRETT & DUN
1300 I STREET NW
WASHINGTON DC 20005

ART UNIT

PAPER NUMBER

1615
DATE MAILED:

09/07/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/614,118

Applicant(s)

CANNELL ET AL.

Examiner

Brian K. Seidleck

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 & 3. 6) ☐ Other:

Papers Received

Receipt is acknowledged of applicant's IDS filed 2/21/01 and IDS and preliminary amendment filed 4/13/01.

Specification

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Information Disclosure Statement

2. The information disclosure statement filed 2/21/01 fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered. In order for the references within the "results from literature search performed by assignee" to be considered, they must be individually listed on a PTO-1449.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 9, 16, 38, 41, 42, 46, 51 and 52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 9, 16, 38, 41, 42, 46, 51 and 52 recite the limitation "said sugar". There is insufficient antecedent basis for this limitation in the claims. It is unclear which sugar applicant is referring back to.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4, and 19-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Wisotzki et al (U.S. Pat. No. 4,900,545).

Wisotzki discloses a hair care composition useful in protecting hair (repairing split ends) comprising a sugars including glucose, mannose, galactose, ribose, arabinose, xylose, fructose, cellobiose, etc., and mixtures thereof. See abstract and Cols.2-3. The treatment preparations are

in the form of aqueous solutions or emulsions, which may be formulated into shampoos or permanent wave setting lotions. See Cols. 3 and 5-6.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over the teachings of Wisotzki et al (U.S. Pat. No. 4,900,545); Koga et al (U.S. Pat. No. 5,660,838); Syed et al (U.S. Pat. No. 5,641,477); and Felardos et al (U.S. Pat. No. 5,866,111).

Wisotzki discloses a hair care composition useful in protecting hair (repairing split ends) comprising a sugars including glucose, mannose, galactose, ribose, arabinose, xylose, fructose, cellobiose, etc., and mixtures thereof. See abstract and Cols.2-3. The treatment preparations are in the form of aqueous solutions or emulsions, which may be formulated into shampoos or permanent wave setting lotions. See Cols. 3 and 5-6. Similarly, Syed teaches the application of a sugar (sucrose, glucose, fructose, sorbitol, and glycerol) during the relaxing of hair for increasing the hair's tensile strength and decreasing the amount of damage done by this heating/chemical treatment. Other sugars useful in protecting the hair are known in the art, including xylobiose. See Koga at abstract and Col. 2. As for the present inventions use of the compositions on

eyelashes, the examiner relies on the additional teachings of Felardos. The reference teaches the use of sugars and their derivatives in mascara formulations. See abstract. These sugars include arabinose, ribose, xylose, lyxose, ribulose, xyulose, etc. See Col. 2.

The prior art teaches that the claimed sugars are useful in protecting keratin fibers from external damage. The art teaches that such sugars may be incorporated into formulations and subsequently treated (permanent wave lotions or relaxing compositions). The sugars are useful in protecting hairs against split ends, increasing tensile strength and reducing damage during harsh treatments. It would have been obvious to use said sugars in hair care compositions to protect hair, since these sugars are known to provide beneficial properties to hair.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Seidleck whose telephone number is (703) 305-4448. The examiner can normally be reached on M-F (6:30am - 5:00pm) Every Wednesday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (703) 308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 305-3592 for After Final communications.

Application/Control Number: 09/614,118

Page 6

Art Unit: 1615

Cannell et al.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Brian K. Seidleck
Examiner
Art Unit 1615

BKS
September 6, 2001

THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
ART UNIT 152-1615